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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/813,852	03/07/1997	RODNEY L. DOCKERY	21651.3	3963
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DALLAS OFFICE OF FULBRIGHT & JAWORSKI L.L.P. 2200 ROSS AVENUE SUITE 2800 DALLAS, TX 75201-2784				
			EXAMINER FISCHER, ANDREW J	
			ART UNIT 3627	PAPER NUMBER

DATE MAILED: 10/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/813,852

Applicant(s)

DOCKERY ET AL.

Examiner

Andrew J. Fischer

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,10,17-23 and 25-28 is/are pending in the application.
- 4a) Of the above claim(s) 1,4,10,17 and 26-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-23 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

CF

DETAILED ACTION

Acknowledgements

1. Claims 18-23 and 25 remain pending in this application.
2. Claims 1, 4, 10, 17, and 26-28 stand withdrawn from consideration as be directed to non-elected claims.
3. This Office Action is given Paper No. 20050930.
4. Unless expressly noted otherwise, all references in this Office Action to the capitalized versions of “Appellants,” or “Applicants” refers specifically the Applicants of record. References to lower case versions of “applicant, ” “applicants,” or “appellants” refers to any or all patent “applicants.” Unless expressly noted otherwise , references to the capitalized versions of “Examiner” in this Office Action refers to the Examiner of record while reference to or use of lower case versions of “examiner” or “examiners” refers to examiner(s) generally.
5. This Office Action is written in OACS. Because of this, the Examiner is unable to control formatting, paragraph numbering, font, spelling, line spacing, and/or other word processing issues. The Examiner sincerely apologies for these errors.

Claim Rejections - 35 USC §102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

Art Unit: 3627

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 18, 19, and 25 are rejected under 35 U.S.C. §102(b) as being anticipated by the telephone book The One Book for Northern Virginia for 1993 (“One Book”). It is the Examiner’s factual determination that the One Book is a periodical. The Examiner takes Official Notice that phone books are published on a early basis (*i.e.* they come out once a year). Thus, the One Book is a periodical. It is the Examiner’s factual determination that One Book is a periodical that contains articles. In this case, the Examiner finds that because One Book directly discloses a coupon section, a “recycling information” section, the “Yellow Pages and Business White Pages” section, One Book is comprised of articles when using the definitions now of record, *supra*. Because One Books is thus a periodical comprised of articles, it is the Examiner’s factual determination that One Book is a magazine. In this case, it is the Examiner’s factual determination that the advertisements for pet supplied (*e.g.* Federal Lock and Safe,” “Marinelife,” “Creatures ‘n Critters” are articles. The articles reference brand name products, *e.g.* “Iams” pet food.

8. The Examiner finds that the magazine is specific to a particular store (*e.g.* a pet store).

Claim Rejections - 35 USC §103

9. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 3627

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 18, 19, and 25 are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over The One Book.¹ It is the Examiner's principle position that the claims are anticipated because of the inerencies the One Book contains articles.

However if not inherent, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the One Book to include general interest articles. Such a modification would have helped give the reader more information about the coverage of the One Book.

11. Claims 18, 20-23 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hawaiian Airlines² in view of The One Book. Hawaiian Airlines discloses a plurality of general interest articles dispersed throughout a magazine (see *e.g.* "Front Desk", page 15, last column, last full paragraph stating that "Hawaiian Airlines offers a deluxe 'Paradise Resorts' package that includes lei greeting and two nights at the Hyatt"); an advertisement (after page 38) directed to Hawaiian Airlines and referencing flights to and from Hawaii; the specific brand (Hawaiian Airlines) is authored under commission by a sponsor of the specific brand in said article (not only is the article under commission—the entire magazine is under commission of Hawaiian Airlines); the specific store appears on the front cover (Hawaiian Airlines appears on the cover of the magazine); and airline tickets are controlled at least in part by Hawaiian Airlines.

¹ See MPEP §2112 expressly authorizing alternative §102/§103 rejections when the question of inherency is present in the anticipation rejection.

² From the Information Disclosure Statement ("IDS") filed June 9, 2004 (Paper No. 53).

Art Unit: 3627

Hawaiian Airlines ad (after page 38) does not directly disclose a coupon. However One teaches the use of brand specific coupons. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Hawaiian Airlines advertisement (found on the page directly after page 38) to include the brand specific coupons as found in the One Book. By limited the airline tickets to Hawaiian Airlines only (and not any airline), Hawaiian Airlines ensures that the advertisements are brand specific. Such a modification would have provided Hawaiian Airlines a method of ensuring that its flight customers take home with them their complimentary copy of Hawaiian Airlines so that they could use the coupon in their next purchased flight.

The One Book directly discloses a coupons keyed to articles containing brand specific information (see e.g. “Marinelife”, “Creatures ‘n Critters” and P.T. Moran Company Pet Food Supplies” which disclose “Science Diet,” “Iams,” and “Nulro Max” “brand name pet foods”). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made modify the Royal Lahaina Luau advertisement to include a coupon for a “Hawaiian pig” or other brand name feature at the luau. Such a modification would have allowed the browsers of Hawaiian Airlines to associate a brand they are familiar with to the luau.

12. Claims 18, 22, and 25 are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Shedd (U.S. 2,215,163) in view of Bullard, Jr. (U.S. 4,968,061)(“Bullard”).

13. Shedd discloses a book that is not restricted to just advertising, see page 1, col.1, lines 2 and 3. Shedd’s Book includes recipes which are articles of general interest and the recipes include a particular product of a distributor which comprises a specific brand, see page 2, col. 1, lines 21- 33 and coupons which are linked to the particular products of the distributor, see page 2, col. 1, lines 33-45. Shedd does not directly disclose that the invention can be a magazine.

Art Unit: 3627

Bullard teaches at col. 2, lines 30-33 that in advertising media books and magazines are equivalent. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use Bullard to execute the invention of Shedd as a magazine as well as a book since Bullard teaches in advertising media books and magazines are equivalent.

14. Claim 19 is alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over the Shedd/Bullard combination discussed above and further view of Lamphere et. al. (U.S. 5,127,674)(“Lamphere”). The Shedd/Bullard combination discloses the claimed invention as discussed above but does not directly disclose the magazine being specific to a particular store. Lamphere shows a promotional booklet that is specific to a particular store, see col. 10, lines 51-61. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use the teaching of Lamphere to make the magazine of the Shedd/Bullard combination specific to a particular store to aid shoppers in finding the advertised products.

15. Claims 20, 21, and 23 are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over the Shedd/Bullard combination discussed above and further view of Lamphere. The Shedd/Bullard combination discloses the claimed invention as discussed above but does not directly disclose who commissioned the articles. However it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the Shedd/Bullard combination to include Lamphere (col. 9, lines 5-12) to sell advertising space in the magazine of Shedd.

16. The Examiner maintains that is old and well known in the art to key coupons for brand name products to other articles. See Bado et. al. (U.S. 4,703,423) Figure 8 where coupons for brand named products are keyed to other articles (*i.e.* a shopping list).

Art Unit: 3627

17. Because Applicants have not objectively indicated and have not redefined claim limitation(s) to have meanings other than their ordinary and accustomed meanings, the Examiner concludes that Applicants have decided not to be their own lexicographer. To support this position, the Examiner relies on the following factual findings. First and as noted in the previous Office Action,³ the Examiner has carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s). Second, the Examiner finds that not only have Applicants not pointed to definitional statements in their specification or prosecution history, Applicants have also not pointed to a term or terms in a claim with which to draw in those statements⁴ with the required clarity, deliberateness, and precision.⁵ Third, after receiving express notice in the previous Office Action of the Examiner's position that lexicography is not invoked,⁶ Applicants have not pointed out the "supposed errors" in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b) (i.e. Applicants have not argued lexicography is invoked). Forth, Applicants' own remarks filed July 13, 2005, Page 14, §IV, expressly state that "Applicant has not asserted that he is his own lexicographer."

³ See the Examiner's previous Office Action mailed April 13, 2005, Paper No. 04032005, Page 6, Paragraph No. 14.

⁴ "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, *at the very least*, point to a term or terms in the claim with which to draw in those statements. [Emphasis added.]" *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

⁵ "The patentee's lexicography must, of course, appear 'with reasonable clarity, deliberateness, and precision' before it can affect the claim." *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998) citing *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).

⁶ See again the Examiner's previous Office Action, Paper No. 04032005, Paragraph No. 14.

Art Unit: 3627

Finally and to be sure of Applicants' intent, the Examiner also notes that Applicants have declined the Examiner's express invitation⁷ to be their own lexicographer.⁸ It remains the Examiner's position that these requirements were reasonable.⁹ Accordingly and for due process purposes, the Examiner gives notice that for the remainder of the examination process (and unless expressly noted otherwise by the Examiner), the heavy presumption in favor of the ordinary and accustomed meaning is not overcome; the claims therefore continue to be interpreted with their "broadest reasonable interpretation" In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).¹⁰ The Examiner now relies heavily and

⁷ *Id.*

⁸ See e.g. *Fuji Photo Film Co. v. ITC*, 386 F.3d 1095, 72 USPQ2d 1769, 1773 (Fed. Cir. 2004) (noting that applicants' failure to correct the examiner's characterization of an element of claim interpretation is nevertheless an indication of how a claim should be interpreted since applicant declined the examiner's express invitation to correct a possible error in claim interpretation: "applicant's attention was called to the examiner's interpretation of [how the element was interpreted by the examiner, and] applicant was invited to correct the examiner's interpretation—an invitation the applicant did not accept.").

⁹ The Examiner's requirements on this matter were reasonable on at least two separate and independent grounds. First, the Examiner's requirements were simply an express request for clarification of how Applicants intend their claims to be interpreted so that lexicography (or even an *attempt* at lexicography) by Applicants was not inadvertently overlooked by the Examiner. Second, the requirements were reasonable in view of the USPTO's goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO's The 21st Century Strategic Plan, February 3, 2003 available at www.uspto.gov/web/offices/com/strat21/index.htm (last accessed October 2, 2005).

¹⁰ See also *In re Bass*, 314 F.3d 575, 577, 65 USPQ2d 1156, 1158 (Fed. Cir. 2002) ("In examining a patent claim, the PTO must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification. Words in a claim are to be given their ordinary and accustomed meaning unless the inventor chose to be his own lexicographer in the specification") (citations omitted); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc); and MPEP §§ 2111 and 2111.01.

Art Unit: 3627

extensively on this interpretation.¹¹ Unless expressly noted otherwise by the Examiner, the preceding claim interpretation principles in this paragraph apply to all examined claims currently pending.

18. Under the broadest reasonable interpretation standard noted above and unless expressly modified in this Office Action, the Examiner maintains his factual findings, legal conclusions, and claim interpretations including the statements and/or definitions of claim limitations as noted in previous Office Action. Those previous definitions are part of the administrative record and, in accordance with *In re Morris*, are provided simply as a factual source to support the Examiner's claim interpretations (and ultimately the Board of Patent Appeals and Interferences claim interpretations if necessary¹²) during ex parte examination.

Response to Arguments

19. Applicants' arguments filed July 13, 2005 have been fully considered but they are not persuasive.

20. While Applicant's definitions may support Applicants' position better, the Examiner is not bound by Applicants' definitions. The Examiner relies on his definitions as noted in the previous office action.

21. Applicants' attempt at traversing the Official Notice findings as stated in the previous Office Action (Paper No. 04032005, Paragraph No. 8) is inadequate. Adequate traversal is a two

¹¹ See 37 C.F.R. §1.104(c)(3) which states in part: "the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability [Emphasis added.]"

¹² See *Gechter v. Davidson*, 116 F.3d 1454, 1460, 43 USPQ2d 1030, 1035 (Fed. Cir. 1997) ("[W]e hold that the Board is required to set forth in its opinions specific findings of fact and conclusions of law adequate to form a basis for our review.").

Art Unit: 3627

step process. First, Applicants must state their traversal on the record. Second and in accordance with 37 C.F.R. §1.111(b) which requires Applicant(s) to specifically point out the supposed errors in the Office Action, Applicants must state why the Official Notice statement(s) are not to be considered common knowledge or well known in the art. In this application, while Applicant(s) have clearly met step (1), Applicants have failed step (2) since they have failed to argue *why* the Official Notice statement(s) are not to be considered common knowledge or well known in the art. Because Applicants' traversal is inadequate, the Official Notice statement(s) are taken to be admitted as prior art. See MPEP §2144.03.

22. Regarding Applicants' discussion of inherency and *Continental Can v. Monsanto Co.*, *Continental Can* involves an issued patent. The Examiner is not bound by the claim interpretations in *Continental Can* because this is ex parte examination. This is a distinction with a difference.

23. Applicants assert that "the Examiner provide, in the next Office Action, documentary evidence that the phone book is a magazine." In response, the Examiner notes that the Examiner has provided this evidence. See the definitions from Merriam-Webster's Collegiate Dictionary, 9th Edition, Merriam-Webster Inc., Springfield, M.A., 1986.

24. Applicants argue that One Book is not particular to a particular store. The Examiner respectfully disagrees. In fact, One Book is particular to many stores as seen by the diversified coupon section. Therefore "a store" is clearly within One Book's scope.

25.

26. Applicants remaining arguments are not persuasive since they appear to rely on Applicants' definitions.

Conclusion

27. References considered pertinent to Applicants' disclosure are listed on form PTO-892.

Unless expressly noted otherwise by the Examiner, all references listed on form PTO-892 are cited in their entirety.

28. The following two (2) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action: MPEP citations to Chapters 100, 200, 500, 600, 700, 1000, 1100, 1300, 1400, 1500, 1700, 1800, 2000, 2100, 2200, 2500, 2600, and 2700 are from the MPEP 8th Edition, Rev. 2, May 2004. All remaining MPEP citations are from MPEP 8th Edition, August 2001.

29. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

30. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicants with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicants for their "Arguments" beginning on page 5 traversing the Examiner's positions on various points. If Applicants disagree with any additional factual determination or legal

Art Unit: 3627

conclusion made by the Examiner in this Office Action whether expressly stated or implied,¹³ the Examiner respectfully reminds Applicants to properly traverse the Examiner's position(s) in accordance with 37 C.F.R. §1.111(b) in their next properly filed response. By addressing these issues now, matters where the Examiner and Applicants agree can be eliminated allowing the Examiner and Applicants to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicants have any questions regarding the Examiner's positions or have other questions regarding this communication or even previous communications, Applicants are strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's immediate supervisor, Robert Olszewski, can be reached at (703) 308-5183. The fax number for facsimile responses is now (703) 872-9306.



Andrew J. Fischer
Primary Examiner
Art Unit 3627

AJF
October 2, 2005

¹³ E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.